

1AP16Rec'd PCT/PTO 27 DEC 2005

78

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Tommy LONG

Appln No.: 10/510,647 ✓

Filed: October 8, 2004 as a 35 U.S.C. 371

National Stage Application, based on

PCT/US03/10857 filed April 9, 2003.

TC/AU: TBD

Examiner: TBD.

Atty. Docket No.: CM-020

**FURTHER RESPONSE TO  
PETITION AND NOTICE OF  
MISSING PARTS**

**For: VEHICLE DRIVE SYSTEM WITH  
ENERGY RECOVERY SYSTEM AND  
VEHICLE MOUNTING SAME**

Customer No:

34253

PATENT TRADEMARK OFFICE

**RECEIVED**

Mail Stop PCT  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

7 FEB 2006

Legal Staff  
International Division

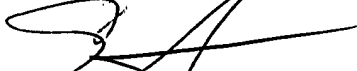
Dear Sir(s):

Further to the response to Assignee's petition dated November 8, 2005 and setting a response date two months from the date of mailing, Assignee has, after significant and protracted effort, obtained the signature of the Inventor and hereby submits the executed declaration and power of attorney for the above identified case.

As this response is made in a timely manner following the date for response set in the above noted petition, Applicant believes no additional fees are due with this response. However, if an extension of time is required or if a greater or lesser fee(s) should be due or a credit be due in this case, Applicant's respectfully apply for such extension and authorized the Commissioner or his representatives to charge or credit deposit account no. 50-3461 and request that they please notify the undersigned accordingly. Should the USPTO Staff or the Examiner believe a teleconference would advance the prosecution of the application, they are encouraged to telephone the undersigned.

Date: Dec. 27, 2005

Respectfully Submitted,



Eric Weierstall

Registration No. 46, 331

1201 PENNSYLVANIA AVE

SUITE 300

Washington, D.C. 20004

Telephone: (202) 661-4610

Telefax: (202) 661-4699



08 NOV 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

Eric Weierstall  
Tangent Law Group  
1201 Pennsylvania Avenue  
Suite 300  
Washington, D.C. 20004

In re Application of  
LONG

U.S. Application No.: 10/510,647

PCT No.: PCT/US03/10857

Int. Filing Date: 09 April 2003

Priority Date: 10 April 2002

Attorney Docket No.: CM-020

For: VEHICLE DRIVE SYSTEM WITH ENERGY  
RECOVERY SYSTEM AND VEHICLE  
MOUNTING SAME

DECISION ON PETITION

UNDER 37 CFR 1.47(b)

This decision is in response to the applicant's "Petition Under 37 CFR 3.47 With Declaration And Fees" filed 26 August 2005 in the United States Patent and Trademark Office (USPTO). For the reasons discussed below, the petition is being treated as a petition under 37 CFR 1.47(b) to accept the application without the signature of inventor Thomas Long.

**BACKGROUND**

On 09 April 2003, applicant filed international application PCT/US03/10857 which claimed priority to an earlier U.S. application filed 10 April 2002. Pursuant to 37 CFR 1.495, the deadline for paying the full, U.S. Basic National Fee was set to expire at midnight on 10 October 2004.

On 08 October 2004, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a First preliminary amendment.

On 27 June 2005, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventor in compliance with 37 CFR 1.497(a)-(b) was required. Applicant was afforded two months to file the required response and advised that this period could be extended pursuant to 37 CFR 1.136(a).

On 26 August 2005, applicant filed the present petition under 37 CFR 1.47(b).

### DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(g); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Therefore, a review of the papers provided finds that applicant has satisfied items (1), (3) and (4).

As to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Presently, applicant has provided a statement from counsel that the "The assignee avers that it has, through its President Michael Fowler, taken and exhausted all diligent efforts to locate and obtain the signature of the inventor on the attached declaration. That the inventor is unavailable at this time." In order to proceed without Mr. Long's signature on the declaration, applicant is required to provide detailed information as to the "diligent effort" such as whether a search of telephone directories or Internet search engines were performed in an attempt to find a current address for the inventor, as well as, the circumstances of his unavailability. As shown, above this information should be provided by an individual with firsthand knowledge of the attempts to locate Mr. Long.

Regarding item (5), applicant's present petition references the inclusion of a copy of the relevant assignment document, however the paper was not included nor does a copy exist in the application file.

As to item (6), applicant states that failure to grant the petition will, "cause extreme hardship to the assignee and the inventor in the loss of patent rights in the above identified application." In order to satisfy item (6), applicant is also required to state that damage caused, i.e. the extreme hardship, would be irreparable.

For the reasons stated above, it is not possible to grant applicant's petition at this time.

### CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(b) is **DISMISSED** **without prejudice**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3294  
Fax: (571) 273-0459



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

U.S. APPLICATION NUMBER NO. 10/510,647	FIRST NAMED APPLICANT Thomas Long	ATTY. DOCKET NO. CM-020
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INTERNATIONAL APPLICATION NO.
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PCT/US03/10857

LA. FILING DATE 04/08/2004	PRIORITY DATE 04/10/2002
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34253  
TANGENT LAW GROUP  
1201 PENNSYLVANIA AVE, NW  
SUITE 300  
WASHINGTON, DC 20004

CONFIRMATION NO. 3918

371 FORMALITIES LETTER



\*OC000000016381117\*

Date Mailed: 06/27/2005

**NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)**

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Indication of Small Entity Status
- Copy of the International Application filed on 10/08/2004
- Copy of the International Search Report filed on 10/08/2004
- Preliminary Amendments filed on 10/08/2004
- U.S. Basic National Fees filed on 10/08/2004
- Priority Documents filed on 10/08/2004

The applicant needs to satisfy supplemental fees problems indicated below.

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Additional claim fees of \$25 as a small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due.
- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date.
- \$65 Surcharge for providing the oath or declaration later than 30 months from the priority date (37 CFR 1.492(e)) is required.

**SUMMARY OF FEES DUE:**

Total additional fees required for this application is \$90 for a Small Entity:

- **\$65** Late oath or declaration Surcharge.
- Total additional claim fee(s) for this application is **\$ 25**
  - **\$25** for 5 total claims over 20.

**ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

CHARITTA A BURT

Telephone: (703) 308-9140 EXT 207

**PART 2 - OFFICE COPY**

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/510,647	PCT/US03/10857	CM-020